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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,690	09/29/2000	Phillip Lee Scanlan	2001.2.5	1584

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EXAMINER

WANG, LIANG CHE A

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/10/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/676,690

Applicant(s)

SCANLAN, PHILLIP LEE

Examiner

Liang-che Alex Wang

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-30 have been examined.

#### *Specification*

2. The substitute specification filed 04/19/2004 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: the amendment is not supported by the original disclosures. For example, “*automatically* displaying simultaneously to a user”. Applicants refer to page 8 line 26 – page 9 line 20 and Figure 7-9 to show the support of such limitation. However, the term “automatically” cannot be found nor described in the specification provided.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Referring to claims 1, 17 and 26 presents the limitation of “*automatically* displaying simultaneously to a user”, and applicants refer to page 8 line 26 – page 9 line 20 and

Figure 7-9 to show the support of such limitation. However, the term “automatically” cannot be found nor described in the specification provided.

6. All dependent claims are rejected to as having the same deficiencies as the claims they depend from.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 6-9, 12, 16-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong et al., US Patent Number 5,497,319, hereinafter Chong, in view of Kato, Derwent-Acc-No: 2000-004258, JP 11-282848, hereinafter Kato.
9. Referring to claim 1, Chong has taught a method of ordering translation of an electronic communication (Col 3 lines 15-20, and figure 1 shows a electronic communication among devices) including the steps of : displaying to a user a translation component (see abstract, this invention is about, user-requested translation from remote server, therefore a translation component is inherently displaying to user for user to submit the translation command to the remote server); at least part said electronic communication (figure 1); user request translation of a electronic communication (Col 3 lines 36-44, lines 58-61); said translation component requesting a translation of said electronic communication by transmitting said selected communication, or an indicator of said electronic

communication to a translation manager (Col 3 lines 36-44, lines 58-61, input text is being transmitted to the receiving interface for translation); said translation manager obtaining a translation of said communication (Col 3 lines 63-67); and said translation manager directing transmission of said translation of said communication to said user (Col 3 lines 50-54, Col 4 lines 13-14, and abstract.)

Chong has not taught clearly taught automatically displaying simultaneously to a user.

However, Kato has taught automatically displaying simultaneously to a user (see figure 1, object are automatically displaying simultaneously to the user on the browser.)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong such that to automatically displaying simultaneously to a user because both Chong and Kato are providing methods for providing translations to users based on user-requests.

A person with ordinary skill in the art would have been motivated to make the modification to Chong because objects and translations must be displayed to user simultaneously in order for user to recognize the translation, otherwise the invention would not serve its purpose.

Futhermore, Chong has not explicitly taught wherein the request for translation is submitted by clicking once on the translation component, and said translation component comprising an object identified as effecting a translation of said electronic communication.

However, Kato has taught the text to be translated is selected by clicking the mouse button and dragging it till required (see Basic-Abstract Novelty "The text to be translated is selected by clicking the mouse button and dragging it till required. The translated text appears on the same location of screen on release of click button of mouse) and said translation component comprising an object identified as effecting a translation of said electronic communication (see figure 1 of Kato, highlighted area are the object identified as effecting a translation.)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong such that to includes the one-click method for requesting translation of the selected communication, because both Chong and Kato are providing methods for providing translations to users based on user-requests.

A person with ordinary skill in the art would have been motivated to make the modification to Chong because difficult foreign language text can also be converted easily just by click and drag operation. The text conversion time is reduced since it translates the text simultaneously thus English learning effect is improved, as taught by Kato (see ADVANTAGE section of Kato.)

10. Referring to claim 2, Chong has further taught the steps of said user providing translation parameters (Col 3 lines 58-61, Col 4 lines 25-28, receiving interface receives sub language control input, and Col 6 lines 65-67.)

11. Referring to claim 3, Chong has further taught wherein said translation parameters include a target language (abstract lines 1-3, Col 4 lines 25-28, translating the input text to the target language.)
12. Referring to claim 6, Chong has further taught the step of said translation manager appending further information to said translation (Col 3 lines 50-54, Col 4 lines 12-14, abstract lines 16-21, it is inherent for the translation manager to append further information such as recipient's info, to the said translation so so the translation could be sent back to the requester.)
13. Referring to claim 7, Chong has further taught wherein said further information is identifying information for correctly return said translation to said user (see rejection to claim 6.)
14. Referring to claim 8, Chong has further taught the step of the translation manager replacing links in the selected communication (Col 3 lines 39-44, lines 49-54, receiving input via a first link is replaced by the second link that used to send the translation back to the recipient.)
15. Referring to claim 9, Chong has further taught the step of the translation manager translating communications links to the selected communication (see rejection to claim 1, this is inherent because the translation manager has to translate the communication linked to the selected communication or the invention would fail to work for its intended purpose.)
16. Referring to claim 12, Chong has further taught the step of said translation manager maintaining user information (Col 7 line 59 – Col 8 line 22, Col 6 lines 63-67).

17. Referring to claim 16, Chong has further taught the step of caching translation of static content of said electroic communication (Col 3 line 62 – Col 4 line 14, the dictionary database is viewed as static content.)
18. Referring to claims 17, 21, 22, 25, claims 17, 21, 25 encompass the same scope of the invention as that of the claims 1-2, 12. Therefore, claims 17, 21, 25 are rejected for the same reason as the claims 1-2, 12.
19. Referring to claim 18, Chong as modified has taught an invention as described in claim 17, and the limitation of claim 18, are well known in the art that a person with ordinary skill in the art would know a application such as Chong as modified could be implemented in wither an explorer bar, a pull-down menu, context menu or a button.
20. Referring to claim 19, Chong has further taught wherein said one click translation component comprises an add-in application for an electronic mail program (Col 20 lines 55-59).
21. Referring to claim 20, Chong as modified has further taught wherein said one-click translation component comprises an application operating within an operating system for translating communications within the operating system (see drawing 1 of Kato, the translation application is used to translate contents appears on a web browser, and it is inherent that a browser is running under a operating system such as Internet Explorer runs under Microsoft Windows.)
22. Referring to claims 26, 28, claims 26, 28 encompass the same scope of the invention as that of the claims 1, 12. Therefore, claims 26, 28 are rejected for the same reason as the claims 1, 12.



23. Claim 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong in view of Kato, and in further views of Kobayakawa et al., US Patent Number 6,119,078, hereinafter Kobayakawa.

24. Referring to claim 4, Chong as modified has taught an invention as described in claim 1, Chong as modified has taught wherein the transmitting step involving transmitting a selected part of the web page (rejection to claim 1, Kato shows a method for translation the portion on the web page by drag or click on the part of web page)

Chong as modified has not explicitly taught wherein the step of transmitting involves transmitting a URL or a web page or the web page.

However, Kobayakawa has taught transmitting the URL or a web page to the translation engine for translation (Col 8 lines 58-67)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong and Kato such that to includes the step of transmitting involves transmitting a URL or a web page or the web page., because all Chong, Kato, and Kobayakawa are providing methods for providing translations to users based on user-requests.

A person with ordinary skill in the art would have been motivated to make the modification to Chong in view of Kato, because transmitting the URL or a web page would allow the system to translate an entire web page at once. Which would give user a more completed translation in once.

25. Referring to claim 5, claim 5 encompasses similar scope of the invention as that of the claim 4, except the claim 5 includes the limitation of an E-mail. Chong has further taught

about the translation could also be implemented on an e-mail system (Col 20 lines 55-59). Therefore, claim 5 is rejected for the same reason as the claims 4 and the teaching further provided by Chong.

26. Claims 10, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong in view of Kato, and in further views of Beurket et al., US Patent Number 6,360,273, hereinafter Beurket.

27. Referring to claim 10, Chong as modified has taught an invention as described in claim 1. Chong and Kato have not taught the step of the translation manager translating currency amounts to equivalent amounts in a user currency.

However, Beurket has taught transformation may be one of several conversions including language translation and currency conversion.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong and Kato such that to includes the currency conversion because all Chong, Kato, and Kobayakawa are providing methods for providing transformation services to users based on user-requests.

A person with ordinary skill in the art would have been motivated to make the modification to Chong in view of Kato, because in most cases, a person needs language translation would also needs currency conversion because different language system may also belong to different currency system in different country, and having a currency conversion included in the system would allow users to convert the currency from a different system to system that the user is familiar with, which provides the convenience to the users.

28. Referring to claim 24, claim 24 encompasses the same scope of the invention as that of the claims 10. Therefore, claim 24 is rejected for the same reason as the claim 10..
29. Claims 11, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong in view of Kato, and in further views of Robinson, US Patent Number 6,5323,310, hereinafter Robinson.
30. Referring to claim 11, Chong as modified has taught an invention as described in claim 1. Chong and Kato have not taught the step of compiling statistical information about said translation manager.

However, Robinson has taught compiling statistical information about a translation system (Col 2 lines 3-14).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong and Kato such that to includes the step of compiling statistical information about said translation manager, because both Chong and Robinson are providing methods for improving translation through a communication network.

A person with ordinary skill in the art would have been motivated to make the modification to Chong in view of Kato, because compiling a list of statistical information would allow the system to know the performance of the system and allow the linguist to correct the errors found in translation, as taught by Robinson (Col 2 lines 6-7.)

31. Referring to claims 23, 27, claims 23, 27 encompass the same scope of the invention as that of the claim 11. Therefore, claims 23, 27 are rejected for the same reason as the claims 11..

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32. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chong in view of Kato, and in further views of Roy, US Patent Number 6,600,725, hereinafter Roy.

33. Referring to claim 13-15, Chong as modified has taught an invention as described in claim 1. However, Chong and Kato have not explicitly taught the step of effecting payment for said translation, and wherein payment is effected by an originator of said communication paying a fee, for displaying said one click translation and the advertiser paying said fee or part of said fee for displaying the translation component.

However, Roy has taught the advertiser pays for the user's services (Col 7 lines 48-63).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong and Kato such that to include the step of effecting payment for said translation, and wherein payment is effected by an originator of said communication paying a fee, for displaying said one click translation and the advertiser paying said fee or part of said fee for displaying the translation component because it is known that service must be paid somehow to keep the business going, and the translation provided by Chong and Kato are a type of service.

A person with ordinary skill in the art would have been motivated to make the modification to Chong in view of Kato, because since the income of the service is important to keep a business running and industry to innovate, there must be some way to collect the money, and a person with ordinary skill in the art would come out with the

ideas for charging such service by either charging the users, the originators, the advertisers or even the sponsors.

34. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chong in view of Kato, and in further views of Dougkis et al., US Patent Number 6,021,426, hereinafter Dougkis. Chong has taught an invention as described in claim 1, Chong fails to teach the step of reducing bandwidth demands by recognizing content of said electronic communication as either static content or dynamic content and caching translated static for future use. However, Dougkis has taught recognizing content of said electronic communication as either static content or dynamic content and caching translated static for future use (Col 2 lines 31-36 and Figures 2 and 3).

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong and Kato such that to includes a step of recognizing the dynamic and static content and caching static for future use because both Chong as modified and Dougkis have disclosed inventions with static and dynamic contents.

A person with ordinary skill in the art would have been motivated to make the modification to Chong in view of Kato, because less data would then be sent from the server to the client to reduce workload and latency. (abstract.)

35. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chong in view of Kato, and in further views of Hall et al., US Patent Number 6,026,375, hereinafter Hall. Chong as modified has taught an invention as described in claim 1, Chong has not taught wherein said one click translation component comprises a smart icon capable of learning

user preference through use by the said user. However, Hall has taught a software agent is capable of learning user preference through use by the said user (Col 6 lines 50-60.)

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to modify the teaching of Chong and Kato such that to includes a software agent which is capable of learning user preference through use by the said user because both Chong as modified and Hall have disclosed a user interactive software that requires user-interactions.

A person with ordinary skill in the art would have been motivated to make the modification to Chong in view of Kato, because it would provide the system to meet the individual needs of a consumer as taught by Hall. (Col 2 lines 36-39.)

#### ***Response to Arguments***

36. Applicant's arguments with respect to claims 1-30, have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (703) 305-8159. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on (703)308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang *fw*  
May 4, 2004

  
HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER